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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,432	12/18/2001	Harry Kargman	KAQ-003	3451
959	7590	11/16/2005	EXAMINER	
LAHIVE & COCKFIELD, LLP.			RAMPURIA, SATISH	
28 STATE STREET			ART UNIT	
BOSTON, MA 02109			PAPER NUMBER	
			2191	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/024,432	KARGMAN ET AL.	
	Examiner	Art Unit	
	Satish S. Rampuria	2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. This action is in response to the amendment received on Sep 13, 2005.
2. New Claim added by the Applicant: 23.
3. Claims cancelled by the Applicant: None.
4. Claims amended by the Applicant: None.
5. Claims pending in the application: 1-23.

Response to Arguments

6. Applicant's arguments with respect to claims have been considered but they are not persuasive.

In the remarks, the applicant has argued that:

- (i) Applicants respectfully disagree that the format conversion discussed in Guck is the equivalent of converting content based in part on device attributes and suggest that it is quite possible to convert format of content (thus making the content compatible with the client device without tailoring the converted content based on device attributes (a step required in Applicants' claims).
- (ii) Guck simply is not directed towards, nor does it disclose, the tailoring of converted content based on device attributes as required by Applicants' independent claims.
- (iii) The combination of references cited by the Examiner, Guck in view of Bickmore, fails to teach or suggest either the providing of a registry containing device information or the use of a generic markup language from which the content is

converted into device specific content using the device attribute information (the limitations missing from Guck discussed above).

Examiner's response:

- (i) In response to applicant's argument, Guck is system discloses on-the-fly conversion to any type of data to any type of format (see the Summary and FIG. 3). More specifically, Guck discloses the conversion of data based up on the client/device (see FIG. 7 and related discussion). Since, Guck is providing the conversion of data based on the client device type it would be inherent to provide the registry of the client device type during the conversion process. Applicants' make general allegations; therefore, the rejection is proper and maintained herein.
- (ii) In response to applicant's argument, Guck is system discloses on-the-fly conversion to any type of data to any type of format, where Guck teaches dynamically modification (tailoring) the characteristics to accommodate formatting requirements requested by the User and/or formatting requirements required by the protocol being used (also, See FIG. 5 and related discussion). Applicants' make general allegations; therefore, the rejection is proper and maintained herein.
- (iii) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of

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ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is noted that the rejection clearly points out where the combination of Guck and Bickmore teach the claimed features and why it would have been obvious to combine their teachings. Applicants' alleges that Bickmore does not teach or suggest providing of a registry... device attribute information. However, this limitation is inherent to Guck's system, see Office Action, page mailed on 6/13/2005. Applicant only makes general allegations and does not point out any errors in the rejection. Therefore, the rejection is proper and maintained herein.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 3, 4, 5, 6, 7, 8, 11, 12, 16, 17, 21, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,848,415 to Guck (hereinafter called Guck).

Per claims 1 and 16:

Guck disclose:

- In a network having an electronic device (fig. 1 and related discussion), a method, comprising the steps of:
- providing content (col. 4, lines 25-27 “Any document... have "content" is stored... database as a resource object”), said content capable of being displayed to a user of a mobile device interfaced with said network (col. 6, lines 11-14 “The network 40 has communication connections to the client 10, the client 20, the client 30 and the client 33, each of which involves different communication protocols”); and
- receiving a request for said content from a user of a mobile device interfaced with said network (col. 4, lines 46-47 “database to set up a requested document in the format appropriate to the User-requester”);

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- retrieving said device information from said at least one registry (col. 4, lines 39-40 “dynamically modify its characteristics to... formatting requirements requested by the User and/or formatting requirements required by the protocol being used”);
- converting said content from a generic markup language into device-specific content in response to said request (col. 4, lines 40-42 “A document... dynamically converted into a wide range of formats”), said converting using said device information, said generic markup language capable of translating content written in said generic markup language into multiple programming languages (col. 4, lines 63-65 “The dynamic conversion technique works equally well for conversion from one resource type to another and/or from one content format to another”).

Although, Guck teach provide the content converter to any device. Guck is silent on providing the registry information for the device. However, this feature deemed to be inherent to the Guck system, Guck system shows converting the content for any device in any format, col. 4, lines 33-39. Guck system would in inoperative if the converted format is not compatible with client device.

Per claims 2, 3, and 12:

Guck disclose:

- translating said content from an original programming language into said generic markup language prior to converting said content into device-specific content (col. 4, lines 55-58 “if the document... requested... is not immediately transferable, the server

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automatically... utilizes a converter object which transforms the document's content to a format compatible with the request”).

Per claims 4 and 11:

Guck disclose:

- providing a translator capable of converting HTML content into said generic markup language content; and translating HTML formatted content into said generic markup language content using said HTML translator (col. 4, lines 67 “converter could convert a plain text file to an HTML file”, also, fig. 3, and related discussion).

Per claims 5 and 6:

Guck disclose:

- marking the generic markup language content with identifiers (col. 8, line 24 “a message document will be assigned a unique “message id””); and
- performing the retrieving of device information from said at least one registry based on one of said identifiers marking said content (col. 8, lines 27-30 “The Resource object created on behalf of the document is assigned “properties” that represent the document's content and identity”).

Per claims 7, 8, and 17:

Guck disclose:

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- providing a set of rules regarding the translating of said content from said generic markup language into device-specific content (col. 4, lines 37-38 “dynamically modify its characteristics to accommodate formatting requirements requested by the User”); and
- applying said rules in combination with said information from said at least one registry to generate device-specific content (col. 4, lines 39-40 “formatting requirements required by the protocol being used”).

Claims 21 and 22 are the computer program product claim corresponding to method claims 1 and 8 respectively, and rejected under the same rationale set forth in connection with the rejection of claims 1 and 8 respectively, above.

Per claim 23:

Guck disclose:

- wherein the device attributes are at least one of the group of memory, storage capacity, communication speed, or type of operating system (FIG. 1 and related discussion).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 9, 10, 13, 14, 15, 18, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guck in view of US Patent No. 6,857,102 to Bickmore (hereinafter called Bickmore) on 1997.

Per claims 9 and 18:

The rejection of claim 8 is incorporated, and further, Guck does not explicitly disclose wherein the at least one user preference is at least one of user interface choices, key mappings, key behavior, functionality, amount of information to be rendered, language, and location.

However, Bickmore discloses in an analogous computer system the at least one user preference is at least one of user interface choices, key mappings, key behavior, functionality, amount of information to be rendered, language, and location (col. 2, lines 41-65 “In client-side navigation, the user is given the ability to interactively navigate within a single web page by altering the portion of the single web page that is displayed at any given time...” it would be obvious to have user choice interface and its functionality).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the method of user preferences of users’ choice as taught by Tokumaru into the method of converting the text the for the target device as taught by Guck. The modification would be obvious because of one of ordinary skill in the art would be motivated to have user preferences of users’ choice to not to provide display restrictions by the server to each device as suggested by Bickmore (col. 3, lines 20-30).

Per claim 10:

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The rejection of claim 1 is incorporated, and further, Guck does not explicitly disclose providing a plurality of stylesheets for said generic markup language; using said stylesheets in converting said content in said generic markup language into said device-specific content.

However, Bickmore discloses in an analogous computer system providing a plurality of stylesheets for said generic markup language; using said stylesheets in converting said content in said generic markup language into said device-specific content (col. 2, lines 25-40 "...A series of style sheets may be attached to a document, each with a weight describing that style sheet's desirability to the document's author. The user can also specify a default style sheet. The browser used by the user to access the distributed network can also define a "default" style sheet...").

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the method of using stylesheets to convert the content for the desired device as taught by Bickmore into the method of converting the text the for the target device as taught by Guck. The modification would be obvious because of one of ordinary skill in the art would be motivated to use the stylesheets to convert the content to desired devices to provide a better display on handheld devices without losing it visibility as suggested by Bickmore (col. 1, lines 10-16).

Per claim 13:

The rejection of claim 10 is incorporated, and further, Guck does not explicitly disclose wherein at least one of said stylesheets converts said generic markup language content into HDML content.

However, Bickmore discloses in an analogous computer system wherein at least one of said stylesheets converts said generic markup language content into HDML content (col. 2, lines 5-12 “Information... be provided from the distributed network at large, but the desired pages must be pre-defined, and custom information extraction and page formatting software must be written to deliver the information to the small device. This is the approach taken in Unwired Planet's UP.Link service, which uses a proprietary mark-up language (HDML)”).

The feature of using stylesheet to convert content into HDML content would be obvious for the reasons set forth in the rejection of claim 10.

Per claim 14:

The rejection of claim 10 is incorporated, and further, Guck does not explicitly disclose wherein at least one of said stylesheets converts said generic markup language content into i-mode content.

However, Bickmore discloses in an analogous computer system wherein at least one of said stylesheets converts said generic markup language content into i-mode content (col. 24, lines 19-28 “The document filtering systems... to extract... information from a document based on commands written by a user in a high-level scripting language... combine page structure navigation, regular expression matching, site traversal, i.e., web crawling, and iterative matching, in addition to re-authoring of the extracted information using the document re-authoring systems and methods...”).

The feature of converting the content into the i-mode content would be obvious for the reasons set forth in the rejection of claim 10.

Per claim 15:

The rejection of claim 1 is incorporated, and further, Guck does not explicitly disclose wherein the amount of said device-specific content that is delivered to said user is based on the display capacity of said mobile device.

However, Bickmore discloses in an analogous computer system the amount of said device-specific content that is delivered to said user is based on the display capacity of said mobile device (col. 4, lines 65-67 to col. 5, lines 1-5 "...automatic document re-authoring capability coupled with document filtering to provide access to arbitrary documents on a distributed network, such as the Internet or an intranet, to devices with limited communications bandwidth and small displays").

The feature of displaying the content within the capacity of the device would be obvious for the reasons set forth in the rejection of claim 10.

Per claim 19:

The rejection of claim 16 is incorporated, and further, Guck does not explicitly disclose wherein said wireless device is a cellular phone, wherein said wireless device is a PDA.

However, Bickmore discloses in an analogous computer system wherein said wireless device is a cellular phone (col. 4, lines 45-64 "The automatic document re-authoring systems and methods of this invention work well with... very limited displays found on current cellular phones...").

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The feature of using devices such as cellular phone would be obvious for the reasons set forth in the rejection of claim 10.

Per claim 20:

The rejection of claim 16 is incorporated, and further, Guck does not explicitly disclose wherein said wireless device is a PDA.

However, Bickmore discloses in an analogous computer system wherein said wireless device is a PDA (col. 4, lines, 45-64 "The automatic document re-authoring systems and methods of this invention work well with displays found in PDAs...").

The feature of using devices such as PDA would be obvious for the reasons set forth in the rejection of claim 10.

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Satish S. Rampuria** whose telephone number is **(571) 272-3732**. The examiner can normally be reached on **8:30 am to 5:00 pm** Monday to Friday except every other Friday and federal holidays. Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: 571-272-2100**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wei Y. Zhen** can be reached on **(571) 272-3708**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Satish S. Rampuria
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Art Unit 2191
11/28/2005


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